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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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William H. Wisecarver III

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EXAMINER

DASS, HARISH T

ART UNIT

PAPER NUMBER

3692

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/970,600	<b>Applicant(s)</b> WISECARVER ET AL.	
	<b>Examiner</b> HARISH T. DASS	<b>Art Unit</b> 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This is in response to applicant's communication of 12/4/2008. The Examiner attempted to contact the attorney (based on interview summary) after receiving and reviewing the amended claims, but attorney did not respond. The only phone call was received regarding the status of the office action.

2. Status of claims;

Claim 1, 3-14 are pending (claims 8-14 are newly added claims).

Claim 2 is canceled.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1 remains rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1, 3, 8-12 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to a machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example **by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.**

Here, applicant's method steps fail the first prong of the new Federal Circuit decision since they are not tied to a machine and can be performed without the use of a particular machine.

The mere recitation of the machine with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. Insignificant extra-solution activity will not transform an unpatentable principle into a patentable process (see John Love, Deputy Commissioner for Patent Examination Policy, memorandum Jan. 7, 2009).

Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al-  
[http://iplaw.bna.com/iplw/5000/split\\_display.adp?fedfid=10988734&vname=ippqcases2&wsn=500826000&searchid=6198805&doctypeid=1&type=court&mode=doc&split=0&scm=5000&pg=0](http://iplaw.bna.com/iplw/5000/split_display.adp?fedfid=10988734&vname=ippqcases2&wsn=500826000&searchid=6198805&doctypeid=1&type=court&mode=doc&split=0&scm=5000&pg=0)

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Particularly, claim 1 “merchant account” and “no funds are stored”; claim 5 “merchant account” and “lock box account does not store funds”, claim 4 “merchant account”.

In order to remove the rejection of new matter, Applicant should clearly show where all the added limitation were disclosed in original specification (specification and original claims). The Examiner reviewed the specification and original claims and did not find support of these limitations or the language of the claims.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3, 8-12, 6-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Particularly, claims 1, 6 “account number” is vague, it is not clear which account is established.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4-6, 8-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheong et al. (hereinafter Cheong – US 7,006,993) in view of Hutchison et al (hereinafter Hutchison – US 20050192896), Cohen (US 2003/0097331 A1), and Mullins et al. (hereinafter Mullins - US 6,352,205).

Re. Claim 1, Cheong discloses opening an account for online shopping [Abstract], and verifying electronically that the Consumer (customer) has an established credit card account [abstract; col. 9 lines 12-20 – see funding a surrogate account...], creating an electronic data account (account) [Abstract; col. 1 line 53 to col. 2 line 25]; authorizing an amount of credit within the financial account of limited access [Abstract; Figures 10, 14; col. 1 line 53 to col. 2 line 25,. executing a purchase transaction having a dollar amount within the established purchasing limit; after executing the purchase transaction, requesting funds from the customer's established credit card account and routing the funds to the merchant; creating a data account number and access code and confirming the credit amount and access code [col. 15 lines 15-18 – see “debit card” which has account number and access code and when it is used the system

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validates the access code and the card limit before processing further], the method further comprising the steps of: accessing a merchant via a computer network [col. 1 lines 18-27; col. 6 lines 18-50]; performing procedures for on-line purchasing [col. 1 lines 18-27; col.6 lines 18-50]; entering the account number, and entering the access code [Figure 2 and associated description; col. 22 lines 32-67]; electronically routing the data account (account) number and access code to a service provider; and routing a request for funds totaling the dollar amount of the transaction to the credit card issuer [figure 47; col.24 lines 33-56; col. 30 lines 52-64]. Cheong does not explicitly disclose establishing (opening) a purchasing limit and storing the purchasing limit in the data account (account), and lock box and where the lock box does not store funds; merchant account and settling the transaction with the consumer's credit card account; routing the dollar amount of the purchase transaction and the entered lock box account number to the lockbox; verifying that the dollar amount of the purchase transaction is within the established purchasing limit and that the entered account number matches the entered lock box account number; completing the purchase transaction if the amount of the purchase transaction is within the established purchasing limit stored in the lock box account.

However, credit card transaction is old and well-known, where the merchant forwards the customer receipt to merchant account bank with total collection amount and during the process the customer's available credit limit is reduced to new value. For example, a customer with outstanding purchasing limit of \$10,234.23 (max limit – total spending up to this point) charges another \$1000.00, the new limit is reduced to

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\$9234.23 (see any consumer's credit card statement), the merchant bank collect the money from credit card company less the credit card fee and forwards to merchant (deposit to merchant account) the collected amount less banks processing fees/commission.

Similarly smart cards are known which have memories for holding the spending limits, upper limit, password, controlling the spending limits and authorization for higher limits, and transaction history and can be used where the merchant does not need to get authorization like regular cards.

Hutchison discloses merchant account, settling the transaction with the consumer's credit card account and a virtual account, establishing (opening) a purchasing limit and storing the purchasing limit in the data account (account) [abstract; para. 55, 65]. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Cheong and include the above feature, as disclosed by Hutchison, to check the payments against the stored data and determine whether a spending limit has been exceeded and prevent the transaction in event the spending is above the limit which reduces fraud and extra cost associated with purchases that may rejected by credit card companies.

Cohen discloses lock box and where the lock box does not store funds [See at least paragraphs 41, 104, 118 "electronic safety deposit **boxes**", 415]. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Cheong and Hutchison and include lock box and where the lock box does not store funds, as disclosed by Cohen,. To provide an electronic



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deposit box associated with the webbank for storage, access, and recordkeeping of a user's important documents and assets and control of fund transfer and authorization of payment in e-commerce.

Mullins discloses routing the dollar amount of the purchase transaction and the entered lock box account number to the lockbox (here - account in database); verifying that the dollar amount of the purchase transaction is within the established purchasing limit (inherent) and that the entered account number matches the entered lock box account number (database account); completing the purchase transaction if the amount of the purchase transaction is within the established purchasing limit stored in the lock box account (inherent). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the disclosure of Cheong, Hutchison and Cohen and include the above features as disclosed by Mullin to provide a pseudo monetary system with database which associates the pseudo account number to actual financial account and allow the customer to use pseudo account number instead of his/her credit card for online purchases and prevent fraud.

Re. Claim 4 & claim 5, claim 4 and claim 5 are rejected with same rational as claim 1.

Re. Claim 6, Cheong creating a data account number and access code and confirming the credit amount and access code [col. 15 lines 15-18 – see “debit card” which has account number and access code and when it is used the system validates the access code and the card limit before processing further], the method further comprising the

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steps of: accessing a merchant via a computer network [col. 1 lines 18-27; col. 6 lines 18-50]; performing procedures for on-line purchasing [col. 1 lines 18-27; col.6 lines 18-50]; entering the account number, and entering the access code [Figure 2 and associated description; col. 22 lines 32-67]; electronically routing the data account (account) number and access code to a service provider; and routing a request for funds totaling the dollar amount of the transaction to the credit card issuer [figure 47; col.24 lines 33-56; col. 30 lines 52-64].

Re. Claim 8-14, all of the limitations of claims 8-14 are disclosed by Cheong in view of Hutchison, Cohen and Mullins

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 & 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheong, Hutchison, Cohen, and Mullins as applied to claims 1 & 5, and in view of Gustin et al (hereinafter Gustin - US 2005/0035193).

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Re. Claims 3 & 7, Cheong discloses debiting the financial account of limited access the amount electronically transferred [col. 1 lines 17-27; col. 2 lines 1-13].

Further, Gustin et al (US 2005/0035193) discloses wiring the amounts of the transaction to the merchant less any discount fee [paragraphs 12-14, 141, 178 – see reduced fee]. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Cheong, Hutchison, Cohen and Mullins and include limitation disclosed by Gustin to improve the payment for online shopping using known wire transferring means to expedite the transaction.

### ***Response to Arguments***

7. Applicant's arguments with respect to amended claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HARISH T. DASS whose telephone number is (571)272-6793. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Abdi Kambiz can be reached on 571-272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Harish T Dass/  
Primary Examiner, Art Unit 3692

3/2/2009